

Oral Hearing:
January 20, 1998

Paper No. 13
GDH/md

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB SEPT 29,98

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Kohl's Department Stores, Inc.

Serial No. 74/735,420

Norman H. Zivin and John R. Garber of Cooper & Dunham LLP for
Kohl's Department Store, Inc.

Jason Turner, Trademark Examining Attorney, Law Office 108
(David Shallant, Managing Attorney).

Before Seeherman, Quinn and Hohein, Administrative Trademark
Judges.

Opinion by Hohein, Administrative Trademark Judge:

Kohl's Department Stores, Inc. has filed an application
to register the mark "M SPORT" and design, as shown below,



for "men's, women's and children's athletic wear and sportswear,

namely, knit tops, knit shorts, knit pants, fleece tops, fleece shorts, fleece pants, jogging suits, socks and shoes."¹

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when applied to its goods, so resembles the mark "M.M. SPORT," which is registered for "clothing; namely, men's, women's and children's tops, bottoms, jackets, dresses, shirts, sweatshirts, sweatpants and vests,"² as to be likely to cause confusion, mistake or deception.

Applicant has appealed. Briefs have been filed and an oral hearing was held. We affirm the refusal to register.

Turning first to consideration of the respective goods, we note that they are identical in part and are otherwise closely related items of apparel. Clearly, if such goods, which would be sold through the same channels of trade to identical classes of purchasers, were to be offered under the same or similar marks, confusion as to the source or sponsorship thereof would be likely to occur. Applicant, we observe, does not contend otherwise on appeal. Instead, applicant maintains that the respective marks are not so substantially similar, particularly when considered in light of several assertedly similar third-party marks which have been registered, as to be likely to cause confusion.

¹ Ser. No. 74/735,420, filed on September 28, 1995, which alleges dates of first use of April 1995. The word "SPORT" is disclaimed.

² Reg. No. 1,521,899, issued on August 3, 1993, which sets forth a date of first use anywhere of January 5, 1986 and a date of first use in commerce of August 10, 1992. The word "SPORT" is disclaimed.

Specifically, applicant has made of record plain copies of the following three third-party registrations:³

³ Applicant has also made of record plain copies of three other third-party registrations, the particulars of which are:

(1) Reg. No. 1,794,325, issued on September 21, 1993, for the mark "B.U.M. SPORT" ("SPORT" disclaimed) for "men's and boys' wearing apparel; namely, T-shirts, sweatshirts, tank tops, woven shirts, sweaters, cardigans, vests, jackets, pants, sweatpants, shorts, hats, caps, coats, shoes, socks, and underwear; and women's and girls' wearing apparel; namely, T-shirts, sweatshirts, tank tops, woven shirts, sweaters, cardigans, vests, jackets, pants, sweatpants, shorts, skirts, dresses, blouses, hats, caps, coats, shoes, socks, and underwear," setting forth dates of first use of February 26, 1993;

(2) Reg. No. 1,829,473, issued on April 5, 1994, for the mark "PM SPORTS" and design ("SPORTS" disclaimed), as illustrated below,



for "clothing; namely, jackets, T-shirts, sweat suits, and sweat shirts," setting forth dates of first use of May 28, 1993; and

(3) Reg. No. 1,960,787, issued on March 5, 1996, for the mark "M&C SPORT" and design ("SPORT" disclaimed), as depicted below,



for "children's and infants' clothing, namely[,] pants, shirts, shorts, leotards, body suits, tank tops, jeans, jackets, coats, sweaters, slacks, dresses, blouses, skirts, jumpers, pant sets, rompers and dressing outfits," setting forth dates of first use of December 1, 1994.

However, as the Examining Attorney points out in his brief, neither applicant's nor registrant's mark contain an initial term which "creates a word or term with meaning" (e.g., "BUM" and "PM"), as is the case with two of such registrations, while the mark in the third

(1) Reg. No. 1,387,593, issued on March 25, 1986, for the mark "M.L. SPORT" ("SPORT" disclaimed) for "ladies' blouses, pants and shirts," setting forth dates of first use of March 10, 1985;

(2) Reg. No. 1,614,947, issued on September 25, 1990, for the mark "M.E. SPORT" ("SPORT" disclaimed) for clothing, namely, men's activewear, namely tops, pants and sweaters," setting forth dates of first use of October 12, 1988; and

(3) Reg. No. 1,766,768, issued on April 20, 1993, for the mark "MV SPORT" ("SPORT" disclaimed), as reproduced below,



for "men's, women's and children's sportswear and outerwear; namely, shirts, pants and shorts; fleece sweat shirts, sweat pants and shorts; jackets, coats and sweaters," setting forth a date of first use of January 5, 1991 and a date of first use in commerce of March 15, 1991.

As to the Examining Attorney's arguments that applicant's mark "M SPORT" and design and registrant's mark "M.M. SPORT," when used in connection with the same or closely related items of wearing apparel, is likely to cause confusion, "[a]pplicant contends that the exact same arguments that the Trademark [Examining] Attorney has made in this case could have been made with equal effect with respect to any of the above referred[-]to registrations, and

registration differs from the marks in issue by an ampersand and the letter "C," thereby differing in sound, appearance and connotation from both applicant's and registrant's marks.

could also have been made in the cases of any of the above marks against each other."

To applicant, the cited "M.M. SPORT is more similar to M.L. SPORT, M.E. SPORT and MV SPORT than it is to M SPORT and Design." Applicant maintains, in view thereof, that:

[N]o likelihood of confusion can exist between M.M. SPORT and M SPORT and Design. If M.M. SPORT, M.E. SPORT, M.L. SPORT and MV SPORT, marks which are far more similar to each other than any are to M SPORT and Design, can co-exist on the register[,] then the owner of the M.M. SPORT mark cannot, as a matter of law, be damaged by the existence of M SPORT and Design on the Register.

Furthermore, according to applicant, "[t]he third[-]party registrations in the present case show that the letter 'M' used in conjunction with another letter and the word "SPORT" is a popular combination," and that the scope of protection to be afforded the cited "M.M. SPORT" mark must consequently be limited.

Finally, applicant argues that in its mark, "the design feature is at least as prominent and dominant as the word portion and will be perceived as such by the purchasing public." Consumers, applicant therefore asserts, "will focus on the design feature as the dominant feature of the mark as a whole to distinguish it from other marks with the same word elements."

We agree with the Examining Attorney, however, that confusion is likely. Our principal reviewing court has noted, as a general proposition, that "[w]hen marks would appear on virtually identical goods ..., the degree of similarity [of the

marks] necessary to support a conclusion of likely confusion declines." *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992), *cert. denied*, 506 U.S. 1034 (1994). Here, as previously indicated, the respective goods are identical in part and are otherwise closely related items of wearing apparel. The respective marks used in connection therewith differ essentially only in the fact that, unlike applicant's "M SPORT" and design mark, the letter "M" is repeated in registrant's "M.M. SPORT" mark. Such repetition results in marks which, when considered in their entirety, are substantially similar in sound, appearance, connotation and commercial impression. Thus, in contrast to such third-party registered marks as "M.L. SPORT," "M.E. SPORT" and "MV SPORT" and design, in which the second letter of the letter pair differs from the first letter, the second letter in the cited registration for the mark "M.M. SPORT" is identical to the first letter.

Consequently, while differences between applicant's "M SPORT" and design mark and registrant's "M.M. SPORT" mark are admittedly apparent on the basis of a side-by-side comparison, the Examining Attorney is correct that such is not the proper test to be used in determining the issue of likelihood of confusion inasmuch as it is not the ordinary way that a prospective customer will be exposed to the marks. Instead, it is the similarity of the general overall commercial impression engendered by the marks which must determine, due to the fallibility of memory and the concomitant lack of perfect recall,

whether confusion as to source or sponsorship is likely. The proper emphasis is accordingly on the recollection of the average purchaser, who normally retains a general rather than a specific impression of marks. See, e.g., *Envirotech Corp. v. Solaron Corp.*, 211 USPQ 724, 733 (TTAB 1981); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975); and *Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller*, 477 F.2d 586, 177 USPQ 573, 574 (CCPA 1973). Here, the repetition of the letter "M" in registrant's mark is simply insufficient, in overall terms of sound, appearance, connotation and commercial impression, to serve to distinguish such mark from applicant's highly similar "M SPORT" and design mark.

Moreover, as the Examining Attorney also correctly points out, with respect to applicant's reliance on the third-party registrations of record, such registrations do not establish that the subject marks are in actual use and that the purchasing public has learned to distinguish such marks based upon the differences in the second letters therein. The third-party registrations, rather than evidencing the "popularity" of a combination of an initial letter "M" with the word "SPORT," are instead entitled to little weight on the issue of likelihood of confusion. See, e.g., *In re Hub Distributing, Inc.*, 218 USPQ 284, 285 (TTAB 1983).

With respect to applicant's contention that the prominent manner in which the letter "M" is displayed in its mark is sufficient to distinguish such mark from registrant's mark, it must be kept in mind, as the Examining Attorney observes, that

because the mark "M.M. SPORT" is registered in a typed format consisting of all capital letters, registrant's rights in its mark encompass all reasonable manners of presentation of such mark, including a prominent display of the letters in the initials "M.M.," with the word "SPORT" shown in a subordinate manner. See, e.g. Phillip's Petroleum Co. v. C. J. Webb, Inc., 442 F.2d 1376, 170 USPQ 35, 36 (CCPA 1971).

We conclude, therefore, that purchasers and prospective customers, familiar with registrant's mark "M.M. SPORT" for men's, women's and children's tops, bottoms, jackets, shirts, sweatshirts, sweatpants and vests and women's and children's dresses, could rationally assume, upon encountering applicant's substantially identical mark "M SPORT" and design for men's, women's and children's athletic wear and sportswear, namely, knit tops, knit shorts, knit pants, fleece tops, fleece shorts, fleece pants, jogging suits, socks and shoes, that such identical and otherwise closely related items of wearing apparel emanate from, or are sponsored by or affiliated with, the same source.

Decision: The refusal under Section 2(d) is affirmed.

E. J. Seeherman

T. J. Quinn

G. D. Hohein
Administrative Trademark Judges,
Trademark Trial and Appeal Board